

Application No.: 10/823,789

REMARKS

Applicant has carefully considered the May 19, 2005 Office Action, and the amendments above together with the comments that follow are presented in a bona fide effort to address all issues raised in that Action and thereby place this case in condition for allowance. Claims 1-32 were pending in this application. In response to the Office Action dated May 19, 2005, claims 1, 2, 31 and 32 have been amended. Care has been exercised to avoid the introduction of new matter. Adequate descriptive support for the present Amendment should be apparent throughout the originally filed disclosure as, for example, the depicted embodiments and related discussion thereof in the written description of the specification. Applicant submits that the present Amendment does not generate any new matter issue. Entry of the present Amendment is respectfully solicited. It is believed that this response places this case in condition for allowance. Hence, prompt favorable reconsideration of this case is solicited.

Initially, Applicant gratefully acknowledges the Examiner's indication of allowable subject matter. Claims 31 and 32 would be allowed if rewritten or amended to overcome the rejection under the second paragraph of 35 U.S.C. § 112. Dependent claims 2-3, 8-13 and 28-29 were objected to as being dependent upon a rejected base claim, but would be allowable if recast in independent form and rewritten or amended to overcome the rejection under the second paragraph of 35 U.S.C. § 112. Dependent claims 5-7 and 14-27 were objected to as being dependent upon a rejected base claim, but would be allowable if recast in independent form. Applicants submit that claims 1-32 are in condition for allowance for the reasons set forth *infra*.

Claims 1-32 were rejected under 35 U.S.C. § 112, second paragraph. Applicant respectfully traverses the rejection.

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Indefiniteness under the second paragraph of 35 U.S.C. § 112 is a question of law. *Tillotson Ltd. v. Walbro Corp.*, 831 F.2d 1033, 4 USPQ2d 1450 (Fed. Cir. 1987); *Orthokinetics Inc. v. Safety Travel Chairs Inc.*, 806 F.2d 1565, 1 USPQ2d 1081 (Fed. Cir. 1986). Accordingly, in rejecting a claim under the second paragraph of 35 U.S.C. § 112, the PTO is required to discharge its initial burden for providing a basis in fact and/or cogent reasoning to support the ultimate legal conclusion that one having ordinary skill in art, with the supporting specification in hand, would not be able to reasonably ascertain the scope or protection defined by the claim. *In re Cortwright*, 165 F.3d 1353, 49 USPQ 2d 1464 (Fed. Cir. 1999). Consistent judicial precedent holds that reasonable precision in light of the particular subject matter involved is all that is required by the second paragraph of 35 U.S.C. § 112. *Miles Laboratories, Inc. v. Shandon, Inc.*, 27 USPQ 2d 1123 (Fed. Cir. 1993); *North American Vaccine, Inc. v. Amercian Cyanamide Co.*, 28 USPQ 2d 1333 (Fed. Cir. 1993); *U.S. v. Telectronics, Inc.*, 8 USPQ 2d 1217 (Fed. Cir. 1988). Applicant stresses that a patent specification must be viewed through the eyes of one having ordinary skill in the art. *Miles Laboratories, Inc. v. Shandon, Inc.*, *supra*.

In applying the above legal tenets to the exigencies of this case, Applicant submits that one having ordinary skill in the art would not have been befuddled by the use of the phrase "between the upper drive portion and lower drive portion", particularly as employed in the context of the claims. With respect to this phrase, Applicant agrees with the Examiner's statement that in accordance with the present claimed subject matter, an envelope can pass between the upper drive portion 201 and lower drive portion 202, as depicted in Figure 25. However, Applicants refer the Examiner's attention to FIGS. 24 and 29, wherein the gripping member 250 also passes between the upper drive portion 201 and lower drive portion 202.

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With respect to the phrase “a plurality of gripping members disposed at intervals along a second drive member”, the specification clearly describes that the gripping members are disposed on and at intervals along a first drive member (chain or belt), as shown in FIGS. 20(a) and 20(b). As such, Applicant has amended claims 1, 2 and 31 to clarify that the gripper members are disposed on and along the first drive member.

With respect to the phrase “the envelope stuffing device registration member” in claim 32, Applicant has amended claim 32 for clarity. Claim 32 now recites that the gripping member is configured to release the envelope following registration of the envelope against the registration member. See FIGS. 12(a)-12(b).

Accordingly, for the reasons set forth above, Applicant submits that one having ordinary skill in the art would not have difficulty understanding the scope of the presently claimed subject matter, particularly when reasonably interpreted in light of the supporting specification. The Examiner provided no arguments to justify why one having ordinary skill in the art would have had difficulty understanding Applicant's claimed subject matter. Therefore, it is respectfully submitted that the imposed rejection of claims 1-32 under 35 U.S.C. § 112, second paragraph is not legally viable and hence, Applicant solicits withdrawal thereof.

Claim 1 was rejected under 35 U.S.C. § 102(b) as being anticipated over Webber (U.S. Pat. No. 4,913,415, hereinafter “Webber”). Applicant respectfully traverses.

The factual determination of lack of novelty under 35 U.S.C. § 102 requires the identical disclosure in a single reference of each element of a claimed invention, such that the identically claimed invention is placed into the possession of one having ordinary skill in the art. *Helifix Ltd. v. Blok-Lok, Ltd.*, 208 F.3d 1339, 54 USPQ2d 1299 (Fed. Cir. 2000); *Electro Medical Systems S.A. v. Cooper Life Sciences, Inc.*, 34 F.3d 1048, 32 USPQ2d 1017 (Fed. Cir. 1994).

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Moreover, in imposing the rejection under 35 U.S.C. § 102, the Examiner is required to specifically identify wherein an applied reference is perceived to identically disclose each feature of a claimed invention. *In re Rijckaert*, 9 F.3d 1531, 28 USPQ2d 1955 (Fed. Cir. 1993); *Lindemann Maschinenfabrik GMBH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 221 USPQ 481 (Fed. Cir. 1984). That burden has not been discharged. Moreover, there are significant differences between the claimed subject matter and the device disclosed by Webber that would preclude the factual determination that Webber identically describes the claimed subject matter within the meaning of 35 U.S.C. § 102.

Specifically, Webber fails to disclose or remotely suggest a high-speed envelope transport and insertion machine comprising, *inter alia*, a plurality of gripping members disposed on and at intervals along a first drive member comprising a chain or belt, as required in claim 1. As admitted by the Examiner, Webber merely discloses belts that are pressed against a sheet and retain the sheet without any gripping member disposed thereon. Webber fails to disclose or remotely suggest a plurality of gripping members disposed on and at intervals along a first drive member (comprising a chain or belt). Accordingly, Webber fails to identically disclose every limitation of claim 1. Therefore, the rejection of claim 1 under 35 U.S.C. § 102(b) should be withdrawn.

Claim 4 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Webber in view of Cohen (U.S. Pat. No. 5,414,977, hereinafter "Cohen"). Applicant respectfully traverses.

Applicant incorporates herein the arguments previously advanced in traversal of the rejection of claim 1 under 35 U.S.C. § 102(b) predicated upon Webber. The secondary reference to Cohen does not cure the argued deficiencies of Webber. Thus, even if the applied references are combined as suggested by the Examiner, the claimed subject matter will not result. *Uniroyal*,

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Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 5 USPQ2d 1434 (Fed. Cir. 1988). Therefore, the rejection of claim 4 under 35 U.S.C. § 103(a) should be withdrawn.

It is believed that all pending claims are now in condition for allowance. Applicants therefore respectfully request an early and favorable reconsideration and allowance of this application. If there are any outstanding issues which might be resolved by an interview or an Examiner's amendment, the Examiner is invited to call Applicants' representative at the telephone number shown below.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,

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